

## REMARKS

Claims 1-9 and 13 were pending in the Application as of the Office Action of April 3, 2009. Claim 13 has been amended with this Response. Claim 15 has been added.

### Claim Objections

Claim 13 is objected to for allegedly failing to further limit the subject matter of a previous claim. Applicant respectfully traverses.

Claim 13 recites an energy absorbing material disposed upwardly of a waterproofing membrane that is positioned directly over a fastener. No preceding claim includes such an element.

Applicant respectfully amends the claims to address the typo “substantialentirety.”

### Claim Rejections Under 35 U.S.C. §102(b)

Claim 13 has been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,649,686 to Backenstow (hereinafter referred to as “Backenstow”). Applicant respectfully traverses.

Applicant notes that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant’s amended claim 13 recites *inter alia*:

“an adhesive applied to said first piece and said second piece, said adhesive adhering said first piece to said second piece, and said first piece to said waterproofing membrane.”

Backenstow does not teach any usage of adhesive to adhere pieces of energy absorbing material together, or usage of adhesive to adhere energy absorbing material to a waterproofing

membrane. In fact, Backenstow does not teach adhesive in general. On the contrary, Backenstow teaches a membrane 16/24 that is affixed to a “first piece 38” via disposal of the membrane 16/24 within a frictionally fitted area between a button 28 and the cap 38 (please see Figure 3 and column 3 lines 5-20). Backenstow also teaches a “second piece 41” that is threadingly affixed to the cap 38 (please see Figure 3 and column 3 lines 38-39).

As neither the frictional fit between the button 28 and the cap 38, nor the threaded connection between the threaded over 41 and cap 38, implicitly or explicitly teach an adhesive/adhering, Applicant respectfully asserts that Backenstow does not teach every element of claim 13. Accordingly, Applicant respectfully submits that claim 13 is not anticipated by Backenstow.

Claims 1 and 4-5 have also been rejected under 35 U.S.C. §102(b) as being anticipated by Backenstow. Applicant respectfully traverses.

Applicant notes that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant first respectfully points out that Backenstow seems to have been applied in error by the Examiner in this rejection. For example, Backenstow does not teach “locating fasteners 75,” “a first piece 40,” or a “membrane M” as alleged by the Examiner. In fact, Backenstow does not teach any elements designated by the reference numeral/letters 75, 40, or M. Aside from this apparent error, Applicant respectfully and *pro arguendo* asserts that there are many obvious deficiencies of Backenstow with regards to claims 1 and 4-5, such as failure to teach a waterproofing membrane disposed atop the energy absorbing material.

#### Claim Rejections Under 35 U.S.C. §103(a)

Claims 1-5 have been rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,977,720 to Kuipers (hereinafter referred to as “Kuipers”) in view of U.S. Patent No. 5,419,666 to Best (hereinafter referred to as “Best”). Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contains some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

In addition, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and **MPEP 2143.01V**.

Applicant respectfully asserts that the proposed combination of Kuipers and Best is improper under MPEP 2143.01V. Applicant respectfully notes that Kuipers teaches a welding material 6 that is disposed between a top membrane 5 and a plate fastener 3. After this disposal, the welding material 6 of Kuipers is taught to be heated so as to fuse a bottom of the membrane 5 and a top of the plate fastener 3 (please see column 3, lines 3-8 of Kuipers). This fusion creates a “tough, strong bond” between the membrane 5 and plate 3.

Via the Examiner’s proposed modification, ***a pad 24 of Best would be placed between the welding material 6 and membrane 5*** of Kuipers, so as to allow for a combination that teaches a first and second piece of energy absorbing material disposed between a fastener top and a waterproofing membrane (as is essentially claimed by Applicant). However, placement of this Best pad 24 between welding material 6 and membrane 5 of Kuipers ***would preclude fusion of material 6 to membrane 5***, thus precluding formation of the tough, strong bond discussed above. Instead, via this proposed addition/modification, ***material 6 would fuse/bond with the pad 24***, leaving no fusion/bond between the material 6 and membrane 5. Without this bond between the heated welding material 6 and the bottom of the membrane 5, Kuipers would be

rendered unsatisfactory for its intended purpose of securely fastening the membrane 5 to the roof (please see column 1, lines 40-41). Accordingly, at least under MPEP 2143.01V, the proposed modification/combination of Kuipers with the pad 24 of Best is improper, and *prima fascia* obviousness does not exist over claims 1-5 with regards to Kuipers and Best.

Claims 6-9 have been rejected under 35 U.S.C. §103(a) as being obvious over Kuipers in view of Best and U.S. Patent No. 5,204,148 to Alexander (hereinafter referred to as “Alexander”). Applicant respectfully traverses.

Claims 6-9 depend from claim 4. Thus, for at least the reasons discussed above, the proposed combination of Kuipers and Best, or Kuipers, Best, and Alexander is improper for teaching every element of Applicant’s claims 6-9. In addition, Applicant respectfully points out that the Examiner is suggesting a modification that would replace the welding membrane 6 of Kuipers with the cover tape of Alexander. Applicant respectfully submits that such a modification would very obviously remove the necessary thermoplastic welding material from Kuipers, thereby rendering Kuipers unsatisfactory for its intended purpose of thermoplastically welding a membrane 5 to a roof. Accordingly, at least under MPEP 2143.01V, a proposed modification/combination of Kuipers with the cover tape of Alexander is also improper, and *prima fascia* obviousness does not exist over claims 6-9 with regards to Kuipers, Best, and Alexander.

### Conclusion

All of the rejections are herein overcome. No new matter is added by way of the present Remarks, as support is found throughout the original filed specification, claims, and drawings. Notice of Allowance is respectfully requested.

If the Examiner has any questions regarding the instantly submitted response, Applicant's attorney respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

Applicant hereby petitions for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) which may be required for entry and consideration of the present Reply.

If there are any additional charges with respect to this response or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorney.

Respectfully submitted,  
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